

REMARKS/ARGUMENTS

Pending claims 1-2, 5-6, 8-9, 12-16, 18, 26-27 and 30 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application No. 2002/0141599 (Trajkovic). Applicant respectfully traverses the rejection, as enclosed herewith is a Declaration under 37 C.F.R. § 1.131 which proves invention the subject matter of these claims prior to the April 3, 2001 filing date of Trajkovic. Accordingly, the rejection of these claims is overcome.

Claims 19-25 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application No. 2002/0013784 (Swanson) in view of U.S. Patent Application No. 2004/0057131 (Hutzel). Applicant respectfully traverses this rejection. As to claim 19, neither reference teaches or suggests a wireless phone that includes a storage medium to store at least one audio file. In this regard, Swanson merely discloses a cellular phone that can communicate data received from a server of a service provider. For at least this reason, the rejection of these claims is overcome. Furthermore, the primary reference Swanson merely teaches a cellular telephone. Nowhere however does Swanson teach or suggest a control unit of the cell phone that combines first and second audio signals and provides the combined signal to a speaker of the cell phone.

Nor does the combination of Swanson with Hutzel teach or suggest such subject matter. Instead, Hutzel merely teaches that a rearview mirror housing may include a microphone. While Hutzel further discloses that audio processing techniques may be used to ensure that vocal inputs to the microphone are distinguished from ambient noises, nowhere does Hutzel teach or suggest that a portable device include a control unit to combine multiple audio signals and provide a combined signal through a speaker of the portable device. Instead, Hutzel discloses that a digital system processor (DSP) that processes input audio signals can be located in a rearview mirror or elsewhere in a vehicle cabin.

Nor is there any motivation to combine the audio transmission system of Swanson with the rearview mirror assembly of Hutzel. In this regard, Swanson discloses an audio data transmission system that includes cell phones as receivers of transmissions. Hutzel instead is directed to a rearview mirror assembly that has various utility functions, including the presence of a microphone.

In light of these disparate references, the Office Action has engaged in the hindsight-based obviousness analysis that has been widely and soundly disfavored by the Federal Circuit. In order to prevent a hindsight-based obviousness analysis, "to establish obviousness based on a

combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed Cir. 2000). This requirement is lacking here.

With respect to claim 19, the Office Action contains no factual support for the motivation, suggestion, or teaching of the manner in which Swanson and Hutzal must be modified to render obvious claim 19. The conclusory statements that “it would have been obvious...to have incorporated such a noise reduction means as taught by Hutzal et al. into the device of Swanson to have a higher quality sound” (Office Action, p. 3) and that both references include some similar components fail to adequately set forth a proper motivation to combine. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2001).

Because the Office Action fails to adduce any factual findings that would support a motivation for, or suggestion of, the alchemy by which Swanson and Hutzal might be modified to yield the subject matter of claim 19, a *prima facie* case of obviousness has not been made.

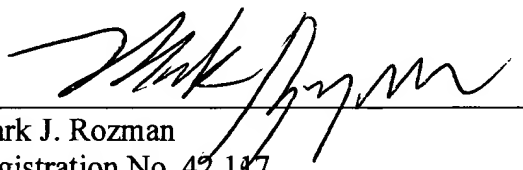
For at least these reasons, claims 19-25 are patentable over the proposed combination.

New claims 31-38 are patentable for at least the same reasons as the independent claims from which they depend.

The application is believed to be in condition for allowance and the Examiner’s prompt action in accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504.

Respectfully submitted,

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APPENDIX